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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/064,807	08/19/2002	Jurg Paul Haller	P 6772.1 US	5715

30008 7590 04/06/2004

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EXAMINER

PARADISO, JOHN ROGER

ART UNIT	PAPER NUMBER
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3721

8

DATE MAILED: 04/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/064,807

**Applicant(s)**

HALLER ET AL.

**Examiner**

John R. Paradiso

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23,27,28 and 30-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23,27,28 and 30-44 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Response to Amendments***

1. In view of the amendments filed 1/16/2004, the objections to the Specification are hereby withdrawn.

***Response to Arguments***

2. Applicant's arguments filed 1/16/2004 have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-23, 27, 28, and 30-44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over GUNTER, JR. ET AL in view of ZEMKE (US 3983679).

GUNTER, JR. ET AL discloses a device for enveloping inserts in an envelope, in which a first article (6) and a second article(s) (5) are fed are fed from a supply to a deflector (25) which directs the first article along a first path (upward) to an insert folding station (50). The second article is directed along a second, generally parallel path along a transport means (41). The second article is passed beneath a stationary adhesive applicator (47), which applies lines of adhesive to the first article along it's edges. An erecting unit (61) positions the first article in an

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upright position before it is folded. (See GUNTER, JR. ET AL column 2 line 46 to column 4 line 18, column 4 line 42 to column 5 line 3, and figures 5A, 5B, 6, and 11.)

GUNTER, JR. ET AL does not disclose the erecting unit erecting the first article from a horizontal position into an upright position and transporting the first article in the upright position.

ZEMKE discloses a device for enveloping inserts in an envelope in which an erecting means (46) erects the first article from a horizontal to a vertical position and then transports the article in an upright position. (See ZEMKE col. 4:1-16 and figure 1.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to transport the articles of GUNTER, JR. ET AL in an upright position, as taught by ZEMKE, in order to facilitate identification of the articles

Regarding claims 8 and 11, the adhesive disclosed in GUNTER, JR. ET AL appears to be cold-setting, however, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use either hot-setting or cold-setting adhesive in the combination of GUNTER, JR. ET AL and ZEMKE, whichever type was most desirable for the consumer market the envelopes would be directed to, since the examiner takes Official Notice of the equivalence of hot-setting and cold-setting adhesive for their use in the packaging art and the selection of any of these known equivalents to seal the envelope would be within the level of ordinary skill in the art.

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Regarding claims 26-27, it would have been an obvious matter of design choice to provide a flattened surface on part of the cylinder, since applicant has not disclosed that providing such a flattened portion solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with any generally cylindrical surface that provided positive control and grip over the articles.

Regarding claims 30 and 34, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the folding elements adjustable in order to accommodate differing consumer needs, since it has been held that the provision of adjustability, where needed, involves only routine skill in the art. *In re Stevens*, 101 USPQ 284 (CCPA 1954).

5. Claims 12-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GUNTER, JR. ET AL in view of ZEMKE, as applied to claim 7 above, and further in view of HELM.

The combination of GUNTER, JR. ET AL and ZEMKE, as described above, does not disclose any of the transport rollers being vacuum-equipped.

HELM discloses an envelope inserting device in which a cylinder (8) is used to direct the flow of envelopes by adhering the envelope to its surface by means of vacuum ports on the surface of the cylinder. The cylinder is linked to a vacuum source to provide the vacuum. (See HELM column 2 lines 31-54.)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of GUNTER, JR. ET AL and ZEMKE by using vacuum-equipped transport rollers, as taught by HELM, in order to more positively control the articles.

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Regarding claim 15, Applicant is given Official Notice that the use of friction coatings on rollers to facilitate the gripping for movement of papers and the like is notoriously well known in the art (and in everyday life, with every office photo-copier providing an example) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to add a friction coating to the gripping rollers in order to provide a more firm and secure grip.

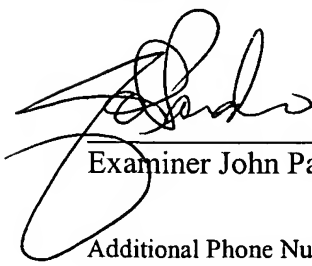
Regarding claims 16-17, Applicant is given Official Notice that the use of sensors to detect the presence of papers and thereby signal a supply roller to shut off operation is notoriously well known in the art (and again, with the same example from everyday life – office photocopiers are often equipped with sensors that signal when papers are present or absent and thereby signal the transport rollers to cease operation, whether vacuum or friction or both).

### *Conclusion*

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Paradiso. The examiner can normally be reached Monday-Friday, 9:30 p.m. – 6:00 p.m. (ET).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada, can be reached at the number listed below.

Any inquiry of a general nature or relating to the status of this application should be directed to the 3700 Technology Center Receptionist.



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Examiner John Paradiso: (703) 308-2825

April 5, 2004

Additional Phone Numbers:

Supervisor Rinaldi Rada: (703) 308-2187

TC 3700 Receptionist: (703) 308-1148

Customer Service: (703) 306-5648

Fax (directly to Examiner) (703) 746-3253

Fax (Official): (703) 872-9306